

REMARKS

Applicants thank Examiner Raymond for the indication of allowable subject matter and for the courteous and helpful discussions with their representative on August 23 and 25, 2004. The results of those discussions are summarized and expanded upon below.

The claims have been limited to the allowable subject matter indicated at paragraph 12 of the Official Action. Method Claims 12, 16 and 20 have been further amended to recite the elected compound.

Claims 1-11, 21-27 and 33-34 have been canceled. Applicants reserve the right to pursue these claims in one or more divisional or continuation applications.

New dependent Claims 35-51 have been added. Support is found at Claims 12, 16, 17, 20 and 28-32 as originally presented and as amended herein.

The specification has been amended as suggested by the Examiner to include the status paragraph.

As was discussed during the interview, Claim 17 is a compound claim - the broadest claim in the case. This claim has been amended so that it no longer includes the property recitations the compound is "capable of." Applicants thank the Examiner for indicating during the discussions that these properties did not inform his search of the claimed compound. This is evident from the text of the anticipation rejection at Official Action paragraph 11, which is that statements of "intended use and/or newly discovered properties do not render products themselves patentable." Support for the broad compound, unfettered by property limitations, is found at the bottom of page 20 in the specification. Favorable consideration of the amendment is respectfully requested.

No new matter is believed to be added by entry of the amendments. Upon entry of the amendments, Claims 12-20, 28-32 and 35-51 will be active and in condition for allowance. Entry and favorable consideration of all amendments is kindly requested.

The obviousness-type double patenting rejections at paragraphs 7 and 8 of the Official Action are unsustainable in view of the present amendments and should be withdrawn. The claims are now limited to that subject matter indicated as allowable by the Examiner, and Applicants kindly request that this ground of rejection be withdrawn.

The rejection of Claims 12-19 and 26-32 for indefiniteness at paragraph 9 of the Official Action is obviated in-part by amendment and is traversed in-part. Applicants have removed the offending "such as" language from the claims and request that this ground of rejection be withdrawn. With respect to the rejection based on the asserted overlap between the J(i) and J(ii) groups in the claims, Applicants kindly traverse on the grounds that such an overlap does not make the claims indefinite: one can easily tell when one is inside or outside the bounds of the claim. The Office has indicated, at least in the context of Markush groups, that double inclusion of an element is not in itself sufficient basis to hold a claim indefinite. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. MPEP §2173.05(h). For convenience, the claim language for the "J" groups appears below, as amended herein:

--wherein J represents (i) a saturated or unsaturated, substituted or unsubstituted, straight or branched acyclic hydrocarbon group; (ii) a saturated or unsaturated, substituted or unsubstituted, straight or branched acyclic group that contains one or more hetero atoms selected from the group consisting of nitrogen, sulfur and oxygen; (iii) a substituted or unsubstituted, saturated or aromatic, mono- or polycyclic group having 3 to 20 carbon atoms; or (iv) a substituted or unsubstituted, saturated or aromatic, mono- or poly- heterocyclic group having 3 to 20 atoms, at

least one of which is a nitrogen, sulfur or oxygen;

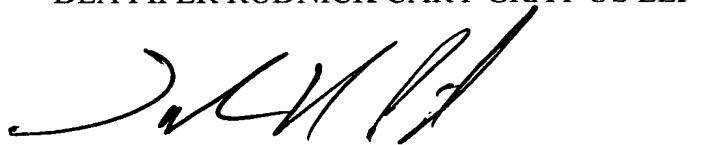
Because one can easily tell from the claim what J is, even if there is an overlap between a substituted group (e.g., wherein the substituent might contain a hetero atom) and a group having a hetero atom, Applicants kindly submit that such language is not indefinite. Either way, one still knows the boundaries of the claim. Withdrawal of this ground of rejection is kindly requested.

The anticipation rejection set out at paragraphs 10-11 of the Official Action is obviated by amendment. The claims have been limited to the allowable subject matter, which was not rejected over the cited references. Applicants kindly request that this ground of rejection be withdrawn.

No prior art being cited to the contrary, this application should now be passed to allowance. Should the Examiner wish to discuss this case further or have any suggestions as how to place this case into even better condition for allowance, he is kindly invited to contact Examiner's below-signed representative at the telephone number below.

Respectfully submitted,

DLA PIPER RUDNICK CARY GRAY US LLP



Steven B. Kelber
Registration No. 30,073
Attorney of Record

1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
Telephone No. (202) 861-3900
Facsimile No. (202) 223-2085

John K. Pike, Ph.D.
Registration No. 41,253

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